

REMARKS

The objection to claims 3, 6 and 7 as being dependent upon a rejected base claim, and the indication that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged. By the present amendment, claim 3, which depended upon claim 2 has been written in independent form incorporating the features of parent claim 2 therein and likewise, claims 6 and 7 which depended upon claim 5 have been written in independent form incorporating the features of parent claim 5 therein. As such, claims 3, 6 and 7 should now be in condition for allowance.

Additionally, by the present amendment, claim 4 has been amended in a manner which should overcome the rejection under 35 USC 112, second paragraph in that the term "near" has been utilized rather than "in the neighborhood of". Further, independent claims 1, 2 and 5 being amended to clarify features of the present invention, as will be discussed below. Also, claims 8 - 10 have been canceled without prejudice or disclaimer of the subject matter thereof, and claim 11 has been amended in a manner to recite the features corresponding to the features as recited in claim 3, which has been written in independent form and should be considered allowable such that claim 11, as amended in an apparatus claim corresponding to the features of method claim 3 and applicants submit that claim 11 and its dependent claim 12 should now be in condition for allowance. Further, claims 13 - 20 have been canceled without prejudice or disclaimer of the subject matter thereof and new claims 21 - 26 have been presented which recite features of the present invention, as will be discussed below.

At the outset, each of the amended independent claims 1, 2, 5, 21, 23 and 25 recite the features whether in method or apparatus form of: (1) repeatedly obtaining image signals of a same portion of a sample by imaging the sample through an optical system by changing optical conditions; (2) adjusting optical conditions of the

optical system by analyzing the repeatedly obtained image signals so as to decrease a difference in contrast in the image signals among segments corresponding to a plurality of regions on the sample (which features (1) and (2) are described in connection with Figure 6 of the drawings of this application and the corresponding description at page 14, line 17 to page 17, line 4 of the specification, for example) and (3) by imaging the sample with the optical system while scanning the sample in a viewing field of the optical system (which feature (3) is described at page 7, lines 19 - 21 of the specification, which describes that an image is detected while a surface of the wafer 1 is scanned in a field of view of an optical system for visual inspection). Applicants submit that such features (1), (2) and (3) which are common to each of the independent claims of this application are not disclosed or taught in the cited art as will become clear from the following discussion.

The rejection of claims 1, 2, 4, 5, 8, 10 - 13, 15 - 20 under 35 USC 102(b) as being anticipated by Maeda et al (5,774,222); the rejection of claims 8 - 15 and 18 - 20 under 35 USC 102(e) as being anticipated by Maeda et al (6,621,571); and the rejection of claims 11, 12, 13, 19 and 20 under 35 USC 102(b) as being anticipated by Worster et al (5,479,252); such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

Applicants note that at least with respect to the rejections of claims as being anticipated by Maeda et al (6,621,571) and Worster et al (5,479,252) since claim 11 has been amended to recite features corresponding to the features found in allowed method claim 3 any rejection with respect thereto should be overcome and the other claims other than dependent claim 12 which depends from claim 11 have been canceled without prejudice or disclaimer of the subject matter thereof. However, applicants note that the following arguments apply to all of the cited art.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

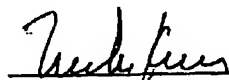
Irrespective of the position set forth by the Examiner with respect to Maeda (5,774,222), Maeda (6,621,574) and/or Worster (5,479,252) taken alone or in any combination thereof, applicants submit that none of these references, disclose or teach the recited features (1), (2) and (3), which are now recited in each of independent claims 1, 2, 5, 21, 23 and 25 and the dependent claims thereof. As recognized in the decision of In re Robertson, supra, each reference must disclose features (1) - (3), and applicants submit that none of these references disclose the recited features (1) - (3). Further, applicants submit that it cannot be considered obvious based on the disclosures of each of these references to provide the features (1) - (3) as now recited in the Independent and dependent claims of this application. Accordingly, applicants submit that in addition to objected to claims 3, 6 and 7, which have been written in independent form and which should now be in condition for allowance, the other claims of this application, i.e., claims 1, 2, 4, 11, 12 and 21 - 26

patentably distinguish over the cited art in the sense of 35 USC 102 and 35 USC 103, and should be considered allowable thereover.

For the foregoing reasons, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (520.40997X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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